



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,513	02/20/2004	Michael L. Obradovich	9800.1038	7591

7590 01/24/2005

Alex L. Yip  
Kaye Scholer LLP  
425 Park Avenue  
New York, NY 10022

EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,513

Applicant(s)

OBRADOVICH ET AL.

Examiner

Jacques H Louis-Jacques

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 16 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/15/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13-15, 17-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by King [4,970,492].

King '492 discloses a method and apparatus for determining excessive engine oil usage, wherein a measure indicative of an extent of performance degradation of a vehicle component (i.e., engine) due to an operation of the vehicle is determined, the measure being a function of at least a duration (abstract). According to King, the duration is added to a cumulative duration (i.e., there is provided an accumulator which accumulates the time (duration) during which the component (engine) of the vehicle is degraded (abstract and figure 1)). As described in the abstract and shown in figure 1, it is determined whether the cumulative duration (i.e., total accumulation) exceeds a predetermined value and an alert (e.g., warning) is provided when the cumulative duration exceeds the predetermined value. In addition, according to King, there is provided a display that

Art Unit: 3661

displays an option causing information about the alert (warning) to be provided, thereby facilitating servicing of the vehicle component (figure 1 and column 2). In column 1, King describes that the measure is also a function of a rate at which the engine runs and the rate is a function of an RPM value (see also column 2).

***Allowable Subject Matter***

4. Claims 16 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not particularly disclose that the duration includes a time during which the engine runs at a rate exceeding a predetermined rate.

***Response to Amendment***

5. The amendments along with the arguments filed therewith on September 15, 2004 have been entered and carefully considered by the examiner.

In particular, Applicant has amended the claims to recite, "the measure being a function of at least a duration" and replace "measure" by --duration--. Emphasis added.

The Terminal Disclaimer filed on September 15, 2004 has been entered and approved.

Accordingly, the obviousness-type double patenting rejections have been withdrawn.

The claims were also rejected as being unpatentable over the patents to Hanson et al and Love et al.

However, Applicant argued that none of the references discloses “determining a measure, which is a “function of at least a duration” nor “adding the duration to a cumulative duration: and “determining whether the cumulative duration exceeds a predetermined value”.

Notwithstanding Applicant’s arguments, in light of the amendments to the claims, a new ground of rejection has been applied against the claims.

Particularly, the patent to King (4,970,492) has been applied against the claims for disclosing the limitations argued by Applicant.

King ‘492 discloses a method and apparatus for determining excessive engine oil usage, wherein a measure indicative of an extent of performance degradation of a vehicle component (i.e., engine) due to an operation of the vehicle is determined, the measure being a function of at least a duration (abstract). According to King, the duration is added to a cumulative duration (i.e., there is provided an accumulator which accumulates the time (duration) during which the component (engine) of the vehicle is degraded (abstract and figure 1)). As described in the abstract and shown in figure 1, it is determined whether the cumulative duration (i.e., total accumulation) exceeds a predetermined value and an alert (e.g., warning) is provided when the cumulative duration exceeds the predetermined value. In addition, according to King, there is provided a display that displays an option causing information about the alert (warning) to be provided, thereby facilitating servicing of the vehicle component (figure 1 and column 2). In column 1, King describes that the measure is also a function of a rate at which the engine runs and the rate is a function of an RPM value (see also column 2).

Art Unit: 3661

In light of the above, the claims remain rejected and this office action is made final, as necessitated by the amendments.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,531,495	Yamato et al	Jul. 1985
4,965,549	Koike	Oct. 1990
5,060,156	Vajgart et al	Oct. 1991
5,499,536	Wier et al	Mar. 1996

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3661

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H Louis-Jacques whose telephone number is 703-305-9757. The examiner can normally be reached on M-Th 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques  
Primary Examiner  
Art Unit 3661

/jlj

*Jacques H. Louis-Jacques*  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER